

## **REMARKS/ARGUMENTS**

### **I. General Remarks and Disposition of the Claims**

At the time of the Office Action, claims 1-70 were pending. Claims 1-26, 28 and 39 are rejected. Claims 1, 5, 9, and 11 have been amended. Claims 2 and 12-70 have been cancelled herein. Claims 71-83 have been added. Applicant respectfully requests that the above amendments be entered, and further requests reconsideration in light of the amendments and remarks contained herein.

On November 17, 2005, during a telephone conversation with the Examiner, claims 1-26, 28, and 39 were provisionally elected in response to the Examiner's restriction requirement with traverse. This provisional election is hereby confirmed, and claims 27, 29-38, and 40-70 have been cancelled. No amendment to inventorship is necessitated by this election. Applicant reserves the right to subsequently take up prosecution on the claims as originally filed in this or an appropriate continuing application.

### **II. Remarks Regarding Rejection of Certain Claims Under 35 U.S.C. § 112**

Claims 2, 5, 11-13, 17, 19, and 21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. (Office Action at 3.)

With respect to claims 2 and 11-13, the Examiner states:

Claims 2, and 11-13 are deemed indefinite insofar as they fail to include at least one positively-recited step. In this regard, the recitation, e.g., "used as a drilling fluid" or "used as a proppant" fails to comprise a positively-recited step. Moreover, it is not clear exactly how the hydrated cement particulates as "used" in the recited manner(s).

(Office Action at 3.) Claims 2, 12, and 13 have been cancelled. While Applicant believes this claim was sufficiently definite, claim 11 has been amended for clarification.

The Examiner has stated that claim 9 is "deemed indefinite with respect to the recitation 'another admixture' insofar as there is no first or initial mixture recited." (Office Action at 3.) Claim 9 has been amended to correct for this inadvertent informality so duly noted by the Examiner.

With respect to claims 5, 17, 19, and 21, the Examiner stated that these claims are “deemed indefinite in being drawn to improper Markush groupings.” (Office Action at 3.) Claims 17, 19, and 21 have been cancelled herein. Although Applicant believes that the language in claim 5 was sufficiently definite to meet the requirements of 35 U.S.C. § 112, Applicant has amended the Markush grouping language in claim 5 per the Examiner’s suggestion. Because the original language was sufficiently definite, there is no change in claim scope because of this amendment.

Applicant respectfully requests that all of the above amendments be entered and submit that these amendments will put these claims in condition for allowance.

### **III. Remarks Regarding Rejection of Certain Claims Under 35 U.S.C. § 102(b)**

The Examiner has rejected claims 1-26, 28, and 39 as being anticipated by U.S. Pat. No. 6,648,962 issued to Berke, et al (hereinafter “*Berke*”). (Office Action at 4.) Claims 2, 12-26, 28, and 39 have been cancelled herein. Furthermore, *Berke* does not anticipate Applicant’s amended independent claim 1, and claims 3-11 depending therefrom, because it does not disclose, expressly or inherently, every element recited in the subject claims as required to anticipate the claims under 35 U.S.C. § 102(b). MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004) (hereinafter “MPEP”).

In particular, independent claim 1, as amended, recites “[a] method of using a drilling fluid in a subterranean formation comprising the steps of: providing a drilling fluid comprising substantially hydrated cement particulates; and placing the drilling fluid into a subterranean formation.” Nowhere does *Berke* disclose these recitations. Rather than disclosing a drilling fluid, *Berke* is directed to a cementing composition (*Berke*, col. 8, ll. 6-15). Accordingly, *Berke* does not disclose a drilling fluid, and thus does not disclose every element of independent claim 1.

Therefore, independent claim 1 is not anticipated by *Berke*. The remaining rejected claims 3-11 depend either directly or indirectly on independent claim 1. All these dependent claims, which include all the limitations of their corresponding independent claim, are allowable for at least the reasons cited above with respect to independent claim 1. Accordingly, Applicant respectfully requests withdrawal of this rejection with respect to claims 1, and 3-11.

#### **IV. Remarks Regarding New Claims 71-83**

Although no rejections have been made to new claims 71-83, to advance prosecution of these claims, Applicant notes that *Berke* does not supply all of the recitations in Applicants' claims 71-83. For example, *Berke* is not directed to a "drilling fluid comprising substantially hydrated cement particulates" as recited in independent claim 71. Thus, Applicant respectfully requests that these claims be passed to issuance.

#### **V. No Waiver**

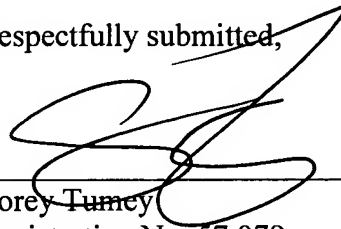
All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed an example distinction from the *Berke* reference. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art. The example distinction discussed by Applicant is sufficient to overcome the anticipation rejections.

**SUMMARY**

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections. Applicant further submits that the application is now in condition for allowance, and earnestly solicits timely notice of the same. Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicant believes that there are no fees due in association with the filing of this Response. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicant respectfully requests that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to Baker Botts L.L.P. Deposit Account No. 02-0383, Order Number 063718.0511.

Respectfully submitted,



Corey Tumey  
Registration No. 57,079  
Baker Botts L.L.P.  
One Shell Plaza  
910 Louisiana Street  
Houston, Texas 77002  
Telephone: 713.229.1469  
Facsimile: 713.229.2769

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